



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants : Almut KRIEBEL et al.)
) Group Art Unit: 1731
Appln. No. : 09/832,873)
) Examiner: M. Alvo
Filed : April 12, 2001)
)
For : PROCESS FOR DISPERSING A FIBROUS PAPER STOCK AND
DEVICE FOR PERFORMING THE PROCESS

REPLY BRIEF UNDER 37 C.F.R. 1.193(b)(1)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is in response to the Examiner's Answer dated October 1, 2003, the period for reply extending until December 1, 2003.

In the Examiner's Answer, the Examiner has withdrawn the rejection of claims 1 - 16 under 35 U.S.C. § 112, second paragraph (Issue (A)), but maintains the grounds of rejection advanced in the final rejection with regard to Issues (B), (C), and (D). Moreover, the Examiner provides arguments in support thereof.

Appellants note that this Reply Brief is being filed under 37 C.F.R. 1.193(b)(1) and is directed to the arguments presented in the Examiner's Answer, and is therefore must be entered unless the final rejection is withdrawn in response to the instant Reply Brief. With regard to this Reply Brief, Appellants note that they are addressing points made in the

Examiner's Answer and not repeating the arguments set forth in the Appeal Brief.

POINTS OF ARGUMENT

First Issue

On page 6 of the Examiner's Answer, i.e., section 13 (*Response to argument*), the Examiner asserts that "[i]t would have been especially obvious to substitute the disperser of FR '047 for the disperser of WO 96/18769 as both are being used to disperse bleach chemicals in to pulp . . . Using one type of disperser for another, e.g., a mallet-type for a disk type, would have been prima facie obvious to the routineer [sic]." While Appellants acknowledge that both devices disperse bleaching chemicals into the pulp, the dispersing devices operate in wholly distinct manners such that there is no suggestion that, upon replacing dispersing device of WO '769 with the dispersing device of FR '047, that the dispersing device would operate in its intended manner.

In particular, as noted by the Examiner, WO '769 discloses a device for *grinding* a particulate material, which facilitates the dispersion of bleach into the pulp. As Appellants have previously pointed out, WO '769 discloses that the grinder can be a disc disperser, and, on page 2, second full paragraph of WO '769, it is disclosed that the grinder is utilized to produce particles "that are so small" that rapid heating of the particles is possible. Moreover, the third and fourth full paragraphs of page 2 of WO '769 discloses that this disperser (grinder) is used as a rapidly rotating shredder, such that "the size of the pulp particles will

be reduced” in order to enable rapid and thorough heating of the reduced sized particles. Thus, while the grinder of WO ‘769 is utilized, in part, to disperse bleach into the pulp, it is also utilized to shred the pulp particles to enable rapid and thorough heating of the reduced sized particles.

In contrast to WO ‘769, FR ‘047 discloses a processing arrangement in which stock is *kneaded* in order to disperse bleach into the pulp. That is, the dispersing device is constructed and operated to as a kneader roll (either horizontally or vertically oriented). In this regard, Appellants submit that the Examiner fails to note that the kneading devices of FR ‘047 are structured to knead the stock suspension, i.e., to massage or mix the stock, whereas the grinder of WO ‘769 is intended to reduce particle size of the pulp. Thus, Appellants submit that, as the kneading device of FR ‘047 is intended to produce a wholly different treatment of the pulp than the grinder of WO ‘769, it would not have been obvious for one ordinarily skilled in the art to utilize such the kneading device of FR ‘047 in place of the grinder of WO ‘769.

In this regard, Appellant submits that rejections based on 35 U.S.C. § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The Examiner has the initial duty of supplying the factual basis for the rejection and may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the

factual basis. *See In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967). As stated in *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984):

[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

Because the kneader roll of FR '047 does not reduce pulp particle size in the manner required by the grinder of WO '769, Appellants submit that there suggestion that the asserted modification would allow WO '769 to operate in its intended manner. That is, the reduced particle size was necessary in WO '769 to ensure rapid and thorough heating of the pulp, but there is no teaching or suggestion in the art of record that the kneading device of FR '047 structured to mix the stock and bleach, with no suggestion of reducing pulp particle size, would produce pulp that can be rapidly and thoroughly heated, as necessitated by WO '769.

Appellants note that, while the Examiner asserts that the translation of FR '047 refers to a grinder and not a kneader, the reference to a grinder is made in regard to the Figure 3 embodiment, which has a wholly different structural arrangement than the kneader rolls of Figure 1 and 2. Thus, assuming, *arguendo*, that the Examiner were to assert a combination of the Figure 3 arrangement of FR '047 with WO '769, then the asserted combination would

fail to provide any teaching or suggestion of the structure of a mallet roll, as is recited in the independent claims.

Accordingly, Appellants submit that, absent the application is improper hindsight, there is no motivation or rationale for combining the applied art in the manner set forth by the Examiner.

Appellants further note that the art of record fails to provide any teaching or suggestion for utilizing the chopper of FR '289 in the environment of WO '769. In particular, Appellants note that the chopper of FR '289 is utilized as a wood chipper, in contrast to the grinder of WO '769 and kneader of FR '047. Moreover, Appellants note that the art of record fails to provide any teaching or suggestion that the wood chipper of FR '289 would have any utility as either a grinder to reduce pulp particle size or as a kneader to mix the pulp. Accordingly, Appellants submit that, absent the application is improper hindsight, there is no motivation or rationale for combining the applied art in the manner set forth by the Examiner.

Therefore, Appellants submit that the art of record fails to teach or suggest any obvious manner of modifying WO '769 (or any other document of record) that would render the instant invention unpatentable.

For the foregoing reasons, Appellant submits that the asserted combination of WO '769 in view of FR '047 and FR '289 is improper for failure to provide the necessary

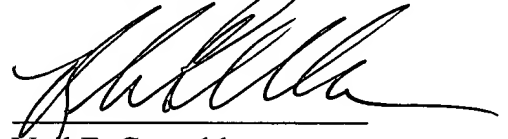
motivation or rationale for combination under 35 U.S.C. § 103(a). Accordingly, Appellants submit that, as the asserted combination is improper, the rejections of the claims based upon this improper combination is likewise improper and should be reversed.

CONCLUSION

For the reasons expressed above, Appellants respectfully request that the grounds of rejection advanced by the Examiner be reversed. Appellants further request that the application be returned to the Examining Group for prompt allowance.

This Reply Brief is submitted herewith in triplicate for the convenience of the Board. Although neither a fee nor an extension of time is believed to be due with this Reply Brief, if an extension of time is necessary, Appellants respectfully request an extension of time under 37 C.F.R. 1.136(a) for as many months as would be required to render this submission timely. Further, the Commissioner is hereby authorized to charge any additional fee due to Deposit Account No. 19-0089.

Respectfully submitted,
Almut KRIEBEL et al.



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